

REMARKS

The present communication is responsive to the Official Action mailed December 11, 2003. In the Official Action the Examiner objected to the specification and rejected the claims on various grounds. Claims 3 and 13 are cancelled as a result of the present amendment. In each of the sub-sections below, applicants respond to each of the Examiner's objections and rejections and discuss the amendments to the claims.

Objections to the Specification

In the Official Action of December 11, 2003 the Examiner again objected to the specification for not including Field Of Invention and Description of Related Art (including information disclosed under 37 C.F.R. §§1.97 and 1.98) sub-sections.

Further in this regard, in Official Actions mailed March 10, 2003 (Paper No. 4) and June 23, 2003 (Paper No. 6) the Examiner objected to the specification because of the omission of Field of the Invention and Description of Related Art sub-sections. Indeed, in each of these Official Actions the Examiner "required" applicants to correct the specification by including each of these sub-sections. In an amendment filed on August 19, 2003, applicants traversed the Examiner's requirement that the specification be amended to include Field of Invention and Description of Related Art sub-sections by pointing out that there was no requirement that the specification include such sub-sections.

Apparently in view of applicants' arguments, the Examiner, by way of the present Official Action, no longer requires that these sub-sections be included, but instead

"request[s]" that applicants include these sub-sections. There is no requirement that these sub-sections be included in the specification.

In addition, the Examiner has already considered the references cited by applicant pursuant to 37 C.F.R §§1.97 and 1.98 (see Paper No. 4) and has not relied on any of these references in rejecting applicants' claim for a third time.

Thus, in view of these facts, applicants respectfully decline the Examiner's request to amend the specification as requested.

Claim Rejections - 35 U.S.C. §112

The Examiner rejected claims 14 and 17 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

With regard to claim 14, the Examiner noted that this claim depended from claim 11, which had been cancelled. Claim 14 has been amended to now depend from claim 12. As such, applicants respectfully submit that claim 14 meets all the requirements of 35 U.S.C. §112.

With regard to claim 17, the Examiner noted that the term "the data" lacked sufficient antecedent basis. Claim 17 has been amended so that the term "the data" is replaced by the term "the first and second characteristic values." As such, applicants respectfully submit that claim 17 meets all the requirements of 35 U.S.C. §112 as the term "first and second characteristic values" has proper antecedence in claim 15.

Applicants have also amended claim 12 to improve its form and recite proper antecedence to other elements in the

claim. In particular, claim 12 has been amended to now recite "means for associating the identity of a first vendor with at least one of the codes." Applicants respectfully submit that this amendment to claim 12 does not constitute the addition of new matter.

Claim Rejections - 35 U.S.C. §101

The Examiner rejected claims 1-3 and 9 under 35 U.S.C. §101 because these claims were directed to non-statutory subject matter. In this regard, the Examiner states that that claims 1-3 and 9 "should claim computer readable code stored on computer readable medium so that [the] instant invention can be considered a practical application in the technological arts." (Official Action, pg. 3.) The preamble of claim 1 has been amended to recite "A computer program product embodied on one or more computer-readable media having instructions executable by a processor for performing a method of providing product information." Applicants respectfully submit that this amendment to claim 1 overcomes the Examiner's rejections under 35 U.S.C. § 101 with respect to claims 1-3 and 9.

The Examiner also rejected claims 1-9, 12 and 15-18 under 35 U.S.C. §101 "because the claimed invention lacks patentable utility." (*Id.*) In particular, the Examiner indicated that recital of the element "changing at least one of the characteristic values" in claims 1, 12 and 15 and the element "modifying the information about the product" in claim 6 rendered all the claims unpatentable under §101. (*Id.*)

The Examiner's assertion that modifying the information or changing the characteristic value as is recited in the claims is not "supported in the specification" is

incorrect. In this regard, applicants respectfully submit that paragraphs [0040] and [0041] of the specification clearly support use of the terms "changing" and "modifying" in the claims. For example, the first sentence of paragraph [0041] states: "Whenever the content in Product Table 320 is modified (e.g., supplemented, deleted, changed, etc.), processor 83 of manufacturer server 71 creates an XML document such that the document's tags relate to the PIIC and value between the tags relates to the modified information."

With regard to the Examiner's assertion that "[e]very possible means of the changing the 'characteristic value' is, therefore, inherently included in Applicant's overly broad claim language, applicants refer the Examiner to M.P.E.P § 2106 II.B which is entitled "Review The Detailed Disclosure and Specific Embodiments of the Invention To Determine What the Applicant Has Invented." Thus, the Examiner's assertion that "a computer glitch, as is often caused by a brief power surge, could change the characteristic value" is without merit in light of what is disclosed in paragraphs [0040] and [0041] and the language in the claim.

Applicants also traverse the Examiner's arguments that claims 1, 6, 12 and 15 lack functionality because (1) "it is unclear why the change is made" and (2) the claims do not "define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permits the data's functionality to be realized." (*Id.*) Applicants are unaware of any requirement to expressly claim a motivation for each step of a claim element. Moreover, the claims are clear regarding the relationship between the change and other aspects of the claim. Specifically, in claims 1, 12 and 15 first and second

characteristic values are stored, one of these characteristic value is changed and sent to a first entity. Claim 6 is similarly clear in reciting a relationship between "modifying information about the product" and the other elements that comprise the claim.

All in all, the Examiner's rejections under 35 U.S.C. §101 are without merit. The specification clearly supports the claimed invention. The specification clearly supports use of the terms "changing at least one of the characteristic values" or "modifying the information about the product." The claims clearly recite a relationship between the information or characteristic value that is modified or changed. As such, the claims meet all the requirements of 35 U.S.C. § 101.

Claim Rejections - 35 U.S.C. §102

The Examiner rejected claims 1, 3-9, 12 and 15-18 under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,913,210 to Call (hereinafter "Call").

Claim 1 has been amended to now recite "associating the identity of a first entity with at least one of the codes including setting one or more update values indicating whether an entity is authorized to receive changes relating to the first or second characteristics associated with the code. . . [and] retrieving the identity of the first entity based on the changed value and one of the one or more update values." Applicants respectfully submit that these amendments to claim 1 do not constitute the addition of new matter. Support for these amendments may be found, for example, in paragraphs [0040] and [0041] of the written description.

Claim 2 has been amended to improve its form in view of the amendments to claim 1. In particular, claim 2 now recites the "computer program product of claim 1 further including associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the changed value and another of the one or more update values and sending the changed value to the second entity." Applicants respectfully submit that the amendments to claim 2 do not constitute the addition of new matter.

Claims 4 and 5 have been amended to improve their form in view of their amendments to the preamble of claim 1. Applicants respectfully submit that the amendments to claims 4 and 5 do not constitute the addition of new matter.

Claim 6 has been amended to recite "providing destination data correlating the information codes to entities, storing an entity-data association, modifying the information about the product, identifying a first entity based upon the information code associated with the product, the product data, the entity-data association and the destination data, and transmitting the modified information about the product to the first entity." Applicants respectfully submit that the amendments to claim 6 do not constitute the addition of new matter as support for these amendments may be found by reference, for example, to paragraphs [0040] and [0041].

Claim 12 has been amended so that the means for associating now recites "including setting one or more update values that provide an indication of whether a vendor is authorized to automatically receive changes to the first or second characteristic values." Claim 12 has also been amended

to recite "means for retrieving the identity of the first vendor based on the changed characteristic value and one of the one or more update values." Applicants respectfully submit that these amendments to claim 12 are fully supported by the written description as indicated above. Applicants respectfully submit that the amendment to claim 12 does not constitute the addition of new matter.

Claim 15 has been amended to now recite "associating the identity of a first entity with at least one of the codes including storing an update value indicating whether the first entity is authorized to automatically receive updates to a characteristic associated with a code, changing at least one of the characteristic values, [and] retrieving the identity of the first entity based on the changed value and the update value." Applicants respectfully submit that the amendments to claim 15 do not constitute the addition of new matter.

In rejecting claim 3, the Examiner states that "Call '210 discloses wherein associating the identity of a first entity with at least one of the codes includes setting an update value, the update value indicating whether the first entity automatically receives changes to the characteristics associated with the code, and wherein achieving the identity of the first entity in which determining the update value [col. 9, lines 20-35]." The portion of Call on which the Examiner relies states the following:

If a manufacturer stores product information in a database, the product directories and the HTML and other data files which are to be made available can be rewritten automatically under program control as the information in the manufacturer's database changes. Alternatively, a request for a particular "file," such as the web page designated "/upcinfo/product-code/info.html," may be intercepted at the manufacturer's server and

handled as a database query to which the server responds by dynamically writing an HTML response page using information in the manufacturer's product database. Available database program development tools, such as Microsoft's Access 97 and Borland's Delphi 3.0, include database manipulation tools which allow programs to be readily written which automate the process of generating product description pages from an existing database.

(Call, col. 9, lns. 20-35.) As the above cited text makes clear, a manufacturer, in accordance with Call's disclosure, and indeed with Call's invention as disclosed, provides information updates in two ways. First, the manufacturer may maintain its own database and automatically rewrite the product directories, the HTML and other data files that are made available to users. Thus, when users access the database they are presented with the most up-to-date information. Second, the manufacturer may intercept a request for a particular file, e.g., a web page, and then may dynamically write an HTML response based on the latest information available in the manufacturer's product database. As such, this portion of Call (as well as the entire disclosure of Call) does not disclose "associating the identify of a first entity with at least one of the codes including setting one or more update values indicating whether an entity is authorized to receive changes relating to the first or second characteristics associated with the code . . . [and] retrieving the identity of the first entity based on the changed value and one of the one or more update values," as is now recited in claim 1. In accordance with Call's invention and disclosure, each user that accesses a manufacturer's web site based on the URL provided by the product code translator 101 is allowed to access any information which the

manufacturer has available in the database. Call does not teach or suggest discriminating between users at all. As such, Call does not disclose "retrieving the identity of the first entity based on the changed value and one of the one or more update values" as is now recited in claim 1.

In addition, Call also does not also disclose "providing destination data correlating the information codes to entities, storing an entity-data association . . . [and] identifying a first entity based upon the information code associated with the product, the entity-data association and the destination data," as is now recited in claim 6. In particular, Call includes no disclosure suggestive of identifying entities based on an entity-data association.

With regard to claim 12, Call does not disclose or suggest "means for associating the identity of a first vendor with at least of the codes including setting one or more update values that provide an indication whether a vendor is authorized to automatically receive changes to the first or second characteristic values [and] means for retrieving the identity of the first vendor based on the changed characteristic value and one of the one or more update values."

With regard to claim 15, Call does not disclose or suggest "associating the identity of the first entity with at least one of the codes including storing an update value indicating whether the first entity is authorized to automatically receive updates to a characteristic associated with a code . . . [and] retrieving the identity of the first entity based on the changed value and the update value"

Indeed, in accordance with Call, a user first accesses the product code translator 101, which provides the

user with the IP address or URL of manufacturers. The user then uses the URL or IP addresses to locate the manufacturer's website and retrieve or access product information. To the extent that the product information has changed, *Call* explicitly teaches that the manufacturer's database would have been updated to reflect the change by the manufacturer or the manufacturer will dynamically include the updated information as such information is requested. Accordingly, all users receive all updates. As such, nowhere in *Call* is it disclosed or suggested that changes to product information is retrieved and sent only to entities that are authorized to receive such updates. Accordingly, for at least this reason, claims 1, 6, 12 and 15 of the present application are not anticipated or obviated by *Call*.

With regard to claims 2, 4, 5, 7-9, 14 and 16-18, as these claims all depend from either claim 1, 6, 12 or 15, applicants' also respectfully submit that these claims are also not anticipated by *Call* for at least the reasons set forth above.

Claim Rejections - 35 U.S.C. §103

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being obvious over *Call*. In particular, the Examiner admits that *Call* "fails to disclose associating the identity of a second entity as that associated with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity." (Official Action, pg. 9.) However, the Examiner asserts that *Call* "discloses the product codes and the Internet addresses are provided by

or on behalf of participating manufacturers and suppliers [col 2, lines 50-52]." (*Id.*)

The Examiner's conclusion is internally inconsistent for at least the following reasons: (1) *Call* could not possibly motivate an ordinary artisan to modify *Call* to perform that which is recited in claim 2 when the Examiner admits that *Call* fails to disclose that which is recited in claim 2; and (2) the Examiner provides no basis as to how the disclosure of *Call* on which he relies suggests associating a first and second entity with the same code. With regard to point (2), it is respectfully submitted that *Call* discloses and suggests using different codes for different manufacturers. (*Call*, col. 3, lns. 19-27.)

As such, applicants respectfully submit that claim 2 is not obviated by *Call* for at least the foregoing reasons.

**Comments on Examiner's Response
to Applicants Prior Arguments**

The Examiner's first response to applicant's first argument is that *Call* discloses "changing at least one of the characteristic values." In support of this response, the Examiner points to col. 2, lines 33-48 and col. 6, lines 2-30 of *Call*. The Examiner places special emphasis on *Call*'s disclosure at col. 2, lns. 43-47 which states: "The product code translator is accessed via the Internet to perform a translation of specified universal product codes into the corresponding Internet addresses from which information about the designated products can be obtained." Thus, it appears that the Examiner is asserting that by "translation" *Call* discloses changing. However, as FIG. 2 of *Call* makes clear translation simply means that the product code translator cross-references IP addresses or URL's with the universal

product code and identity of a manufacturer. Simply put, Call is clear in stating that the product code translator does not change a characteristic value associated with a product (*Id.*, col. 3, ln. 46 through col. 8, ln. 8.)

The Examiner also places emphasis on Call's disclosure that "Note also that, because URL/IP address assignments may be added, altered or deleted on a daily basis" that Call discloses changing at least one of the characteristic values. (*Id.*, col. 6, lns. 20-30). The Examiner's reliance on the portion of Call is misplaced because Call discloses that it's the InterNIC that alters or changes the URL/IP address assignments. Further in this regard, it is interesting to note that the Examiner does not emphasize the entire sentence on which he relies. In particular, that sentence states "Note also that, because URL/IP address assignments may be added, altered or deleted on a daily basis by InterNIC (URL assignment authority), updates to the DNS tables should always be reflected by automatic updates to the cross-reference table IP-Address fields." [Emphasis added.] (*Id.*, lns. 21-25.) Indeed, the sentence is abundantly clear in stating that it's the InterNIC that alters the URL's, which is a completely different entity than the product code translator. As such, the Examiner takes entirely inconsistent positions in interpreting Call and in interpreting the claims.

In responding to applicant's second argument the Examiner defines the first entity to be Call's product code translator. This necessarily leads to the conclusion that it's the manufacturer that retrieves or identifies the first entity based on the product code associated with the characteristic value or information about the product. The

Examiner fails to appreciate, however, that Call does not disclose retrieving the identity of the product code translator based on a characteristic value or information associated with a product. Simply put, Call discloses that the product code translator simply allows manufacturers to register their Internet addresses, product codes and other information identifying them as manufacturers and the product code translator thereafter directs a user to the IP address or URL provided by the manufacturer. (*Id.*, col. 6, lns. 31-62.) In this regard, Call does not disclose that a product code is associated with the product code translator.

In responding to applicant's third, fourth and fifth arguments, the Examiner requests, pursuant to 37 CFR §1.111(b) that applicants' point out the errors in the Examiner's action. In view of the foregoing, the undersigned respectfully submits that applicants have pointed out the errors in the Examiner's actions as discussed in detail hereinabove and in view of same respectfully request reconsideration of all the claims currently pending in the application, namely, claims 1, 2, 4-9, 12 and 13-18. In addition, as it is believed that all the Examiner's rejections have been fully met applicants respectfully request immediate allowance of all the pending claims. If the Examiner does not believe that the claims are in condition for allowance, applicants respectfully request an interview with the Examiner and his supervisor so as to advance this application towards allowance and issuance.

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If for any reason the Examiner does not believe that this amendment can be entered at this time, it is respectfully

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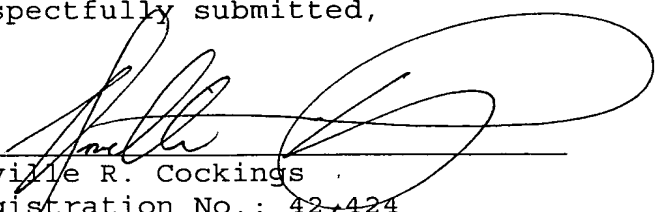
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requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested supplemental amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: March 11, 2004

Respectfully submitted,

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